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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/669,547
Filing Date: September 24, 2003
Appellant(s): SLAVTCHEFF ET AL.

MILTON HONIG
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 22, 2006 appealing from the Office action mailed on April 5, 2006.

Art Unit: 1617

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,546,112

LAHANN

10-1985

Art Unit: 1617

3,843,780	MICHAELS	10-1974
6,749,840 B2	ORLOW ET AL.	06-2004
5,756,077	SYED ET AL.	05-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 10, 11, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaHann et al. (US 4546112) ("LaHann") in view of Michaels et al. (US 3843780) ("Michaels").

LaHann teaches a method of preventing and/or reducing skin irritation caused by thioglycolate depilatory agent by applying capsaicin and/or its salts to the depilated area. See abstract. The reference specifies that the term "depilated area" there refers to the area which is, or is about to be, depilated by treatment with a thioglycolate depilatory agent. See col. 2, lines 41-43; instant claim 4. The reference teaches to formulate the anti-irritant composition in the form of lotions, creams, or solution, and also teaches using lipophilic emollients including hydrocarbon oils, silicone oils, and various natural and synthetic esters. See col. 3, line 9 – col. 5, line 57; instant claims 1 and 2. Example 3 illustrates the method

Art Unit: 1617

of applying a composition comprising an anti-irritant composition, and subsequently applying the depilatory agent after 2 hours. See 5 and 6.

With respect to claim 10, the reference teaches that increase in the anti-irritation agent generally provided more effective irritation prevention or reduction in both the treated and untreated skin. See example 3. Thus it is viewed obvious that a skilled artisan would have adjusted the amount of the ratio of the pretreatment composition and depilatory composition with expectation that more amount of the pretreatment will more effectively prevent skin irritation caused by the depilatory agent.

While the reference generally teaches using an anti-irritant composition in the form of lotions, creams, solution, or gel, the reference does not teach an oil-based composition comprising 90-100 % of lipophilic materials.

Michaels teaches using mineral oil to make a pretreatment composition for shaving to provides comfort, soothing effect to the skin, and no irritation. See col. 1, lines 28 –56; Example 1. The reference teaches a formulation comprising 75-85 % of mineral oil and up to 2 % of emollient such as lanolin. See col. 1, line 11 – col. 2, line 45.

Michaels teaches using up to 87 % of lipophilic materials, while present claims 1 and 16 require at least 90 %. Claim 11 requires at least 98 % of lipophilic materials. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to

Art Unit: 1617

discover the optimum or workable ranges by routine experimentation.” See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235. In this case, the prior art teaches the general condition of the oil-based composition to prevent skin irritation from shaving. It is viewed that a skilled artisan would have discovered by routine experiments the workable range of mineral oil and lanolin to make a composition comprising above 87 % of the oil ingredients.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of LaHann by using with an oil-based composition as motivated by Michaels because (i) LaHann teaches mineral oil as a suitable emollient for the composition; (ii) Michaels specifically teaches that the mineral oil-based composition provides comfort, smoothing effect to the skin with reduced or no irritation. The skilled artisan would have had a reasonable expectation of successfully producing a stable anti-irritant oily composition containing mineral oil, which provides comfort and soothing effect to the skin.

With respect to claim 16, the transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. See *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See *PPG Industries v. Guardian Industries*, 156 F.3d at 1355, 48 USPQ2d at 1355. In this case, the phrase “consisting essentially of” is

Art Unit: 1617

construed as "comprising" because there is no disclosure in the specification or claims that using 90-100 % of is the basic and novel characteristic of the present invention.

With respect to the phrase "the lipophilic materials protecting skin from redness/erythema", it is viewed that practicing the prior art method of applying a pretreatment composition comprising the high content of lipophilic material would obvious result in the skin protection. The fact that appellants has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Claims 7, 12-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaHann in view of Michaels and Orlow et al. (US 6749840 B2) ("Orlow").

As discussed above, LaHann teaches the method of treating skin area to be, or that is, depilated with a composition comprising lipophilic emollient before or after applying a composition comprising thioglycolate depilatory agent. See instant claims 13 and 15. Since the reference teaches that the pre- or post-treatment anti-irritant composition comprises a dermatologically acceptable carrier, it is obvious that the topical depilatory agent composition is also provided by a suitable carrier. See instant claim 7 (b), (ii).

Also discussed above, Michaels teaches using a composition comprising up to 85 % of mineral oil and up to 2 % of lanolin to make a pretreatment composition

Art Unit: 1617

for shaving to provides comfort, soothing effect to the skin, and no irritation. See col. 1, lines 28 –56; Example 1. See instant claim 14.

Michaels teaches using up to 87 % of lipophilic materials, while present claims 7 and 17 require at least 90 %. Claim 12 requires at least 98 % of lipophilic materials. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” See In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235. In this case, the prior art teaches the general condition of the oil-based composition to prevent skin irritation from shaving. It is viewed that a skilled artisan would have discovered by routine experiments the workable range of mineral oil and lanolin to make a composition comprising above 87 % of the oil ingredients.

With respect to claim 17, the transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. See In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See PPG Industries v. Guardian Industries, 156 F.3d at 1355, 48 USPQ2d at 1355. In this case, the phrase “consisting essentially of” is

Art Unit: 1617

construed as “comprising” because there is no disclosure in the specification or claims that using 90-100 % of is the basic and novel characteristic of the present invention:

Also in claim 17, with respect to the phrase “the lipophilic materials protecting skin from redness/erythema”, it is viewed that practicing the prior art method of applying a pretreatment composition comprising the high content of lipophilic material would obvious result in the skin protection. The fact that appellants has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

LaHann does not specifically mention providing pretreatment composition and depilatory composition in a kit with a printed instruction insert in the kit.

Orlow teaches that it is a well known practice in personal care composition art to package the products with a printed instructions as a label or package insert directing the use of such composition. See col. 18, lines 43 – 56. See instant claim 7.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to modify the teachings of the combined references by packaging the anti-irritation composition and depilation composition with a printed instruction as motivated by Orlow because LaHann requires applying these compositions in sequence and Orlow teaches that a printed instruction is conventionally packaged with personal care products. The skilled artisan would

Art Unit: 1617

have had a reasonable expectation of successfully producing a kit that would be helpful for the consumers to properly use the product in convenience.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaHann, Michaels, and Orlow as applied to claims 7, 12-15, and 17 above, and further in view of Syed et al. (US 5756077) (“Syed”).

The combined references fail to teach adding textile materials to the kit.

Syed teaches hair protectant compositions. The reference teaches providing kits for a hair processing chemical composition and the protectant composition for the previously processed hair that are sequentially used. See col. 3, lines 12 – 32. The reference also teaches incorporating applicator, cotton (textile), and/or gloves. See col. 3, lines 24 – 32. See instant claims 8 and 9.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the kit of the combined references with applicators such as cotton or gloves as motivated by Syed because the reference teaches that it is well known in personal care art to insert applicators for the consumers to handle chemical treatment compositions. The skilled artisan would have had a reasonable expectation of successfully providing a depilation composition kit that can be safely and conveniently used by the consumers.

(10) Response to Argument

The main issue in this case is whether, given that it is well known to prepare the area skin to be depilated by applying an anti-irritant composition, a skilled artisan would have been motivated to substitute the capsaicin –containing pretreatment composition in depilation process with a mineral oil-based

Art Unit: 1617

composition which is well known as a pretreatment composition in shaving. According to Michaels, one of ordinary skill in the art at the time of the present invention knew that the mineral oil is applied to the skin prior to shaving and soothes the skin and eliminates skin irritation. Both LaHann and Michaels suggest reducing or eliminating skin irritation during their respective hair removal process by preparing the area of the skin from which the hair is removed by applying a pretreatment composition. Both depilation and shaving process are in hair removal art, thus the skilled artisan would have reasonably found a motivation to substitute the mineral oil composition of Michaels for the capsaicin-containing composition of LaHann in expectation of similarly achieving anti-irritation effects in depilation. Examiner asserts that a prima facie case of obviousness has been established in this case.

A. Claims 1-6, 10-11 and 16 are properly rejected under 35 U.S.C. § 103 (a) over LaHann in view of Michaels.

Appellants asserts that the present invention differs in "concept and composition from that of the primary reference" because capsaicin in LaHann is a dermatologically active chemical wherein appellants' lipophilic material such as mineral oil is used as a mere coating material. It has been held that a prior art reference must either be in the field of appellants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellants was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, examiner takes the position that LaHann and Michaels are analogous

Art Unit: 1617

arts because both are concerned with reducing preventing and/or reducing skin irritation caused by hair removal process, which is the problem with which appellants is concerned.

Appellants state, "lipophilic materials are believed to coat the skin thereby serving as a blanket protection against the subsequent application of caustic depilatory. The depilatory 'sees' the keratin fibers but is shielded by the lipophilic materials from contact with underlying skin". Examiner respectfully disagrees with appellants' broad remarks. According to the references, a skilled artisan would have considered mineral oil as a beneficial cosmetic agent rather than as a mere coating material as 1) LaHann teaches that hydrocarbon oils are used as emollients in the pretreatment composition, and 2) Michaels teaches that mineral oil provides comfort, soothing effect to the skin and no irritation when it is applied prior to shaving. In fact, Michaels teaches that the viscosity of the lipophilic material and additives affect the way mineral oil is deposited on the skin. See Michaels, col. 2, lines 25 – 46. This is contrary to appellants' assumption that all lipophilic material would hinder hair-removing process.

Both capsaicin and mineral oils are well-known anti-irritants used in hair removal art. In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. See In re Ruff, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution

Art Unit: 1617

obvious. See In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982). In this case, even though the mechanism of one anti-irritant may differ from the other, a skilled artisan would have still found the two components interchangeable because these are art-recognized equivalents.

Appellants' statement "irritation caused by razor attack is much different than the effect of chemical burn" is not supported by any evidence. Even if appellants' claims were true, there is no showing that a method of reducing skin irritation caused by razor will have no effect on chemically irritated skin. Mineral oil is not the agent that causes the depilation or shaving process itself; it is merely used as an aid to the process that mitigates the skin irritation that is induced by the removal of hair. It is obvious that a reasonable skilled artisan would have found that mineral oil, which reduces skin irritation that is caused by shaving, would also reduce the skin irritation that is caused by depilatory hair removing process.

Appellants assert that the claimed weight amount of lipophilic material is different "in kind and quantity", and argues that Michaels "teaches away" from using "anything in excess of 85 %". Appellants also claim that 15 % of anhydrous alcohol will change the "character of the mineral oil containing composition". However, the reference in fact indicates that both anhydrous alcohols and the viscosity of mineral oil are the factors that affect the spreading of the mineral oil on the skin. See col. 2, lines 25 – 46. Less viscose the mineral oil, less anhydrous alcohol will be used. Furthermore, the reference also teaches using emollient components, which are lipophilic materials and added to the weight amount of the lipophilic phase. Thus, whether the pretreatment composition contains 85 % or 90

Art Unit: 1617

% of lipophilic material appears not to be critical, since a skilled artisan would have known the spreadability of the pretreatment composition depends on the viscosity of mineral oil and not only on the amount of anhydrous alcohols.

Appellants also argue that using mineral oil in the Michaels method is different “in kind” because it is “intended to lubricate the skin, the hair and the razor” to lubricate the skin”. However, appellants have ignored another crucial teaching in the reference regarding the advantage of using mineral oil – elimination of skin irritation, which is what LaHann and appellants have sought in order to improve the hair removal process.

Appellants also assert that In re Aller is not applicable in this case because at issue in that case was a rejection over a single reference, wherein the present rejection combines two different references. Examiner is not aware of any restriction that this case law is limited only to a specific instance where an obviousness rejection at issue is made with a single reference only.

B. Claim 16 is properly rejected under 35 U.S.C. 103(a).

In response to the examiner’s treatment of the transitional phrase “consisting essentially of” as “comprising” in pursuant to MPEP § 2111.03, appellants refers to Example 1 and 2 in the specification on paragraphs [00040]-[00045]. The cited disclosure there merely describes that the pretreatment with mineral oil produced effective depilation and less irritation. There is no showing in appellants’ disclosure that introducing additional materials to this skin pretreatment composition would somehow affect the depilation and the reduction of skin

Art Unit: 1617

irritation results. Thus, examiner maintains the position that the phrase "consisting essentially of" should be construed as "comprising" in this case.

Appellants also raises an issue as to whether it is proper to address the limitation "the lipophilic materials protecting skin from redness/erythema" as "an inherent result". Examiner respectfully asserts that the rejection is fully supported by Ex parte Obiaya. See 227 U.S.P.Q. 58 (Bd. Pat. App. & Inter. 1985), which holds "the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious". In this case, the combined teachings of LaHann and Michaels render obvious the present method of using mineral oil (a lipophilic material) as a pretreatment composition to reduce skin irritation caused by depilatory process. Examiner views that, what appellants have observed as the result of practicing the present invention, i.e., the reduction of redness/erythema of the skin when mineral oil is used as a pretreatment composition, would naturally flow from carrying out the depilation process as motivated by the teachings of the combined references.

While appellants assert that no prima facie case of obviousness has been made in this case, examiner respectfully disagrees for the reasons set forth above.

C. Claims 7, 12-15 and 17 are properly rejected under 35 U.S.C. § 103 (a) over LaHann and Michaels, and further in view of Orlow.

With respect to the § 103(a) rejection made over LaHann and Michaels and further in view of Orlow et al. (US 6749740 B2), appellants highlight what each reference fails to teach. In response to appellants' arguments against the

Art Unit: 1617

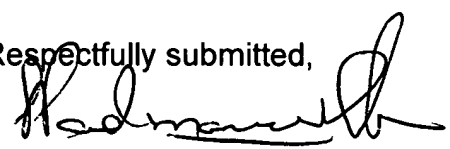
references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claims 8 and 9 are properly rejected under 35 U.S.C. § 103 (a) over LaHann Michaels and Orlow, and further in view of Syed.

Appellants' arguments with respect to the § 103(a) rejection made over LaHann, Michaels and Orlow and further in view of Syed et al. (US 5756077), are also unpersuasive, as the above preceding rejections are viewed proper and maintained for the reasons of record. The fact that Syed is directed to hair coloring composition does not negate the fact that a skilled artisan would have been motivated to use textiles as an applicator for chemical compositions in order to protect his hands. Combining Syed with other prior arts is proper in this case, since both Syed and appellants are commonly concerned with safety and convenience in topically administering potentially harsh chemicals.

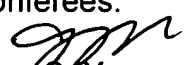
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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